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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: BRUCE P. WILLIAMS, ET AL

Serial No.: 09/682,594

Art Unit: 3727

Filed: September 25, 2001

Examiner: N. J. Newhouse

For: CONFIGURABLE ROOF RACK SYSTEM

Commissioner for Patents

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on 4/9/2004

by *Larry W. Miller*
Larry W. Miller

Dear Sir:

SUBMISSION OF APPELLANTS' BRIEF ON APPEAL

Please find attached hereto in triplicate Appellants' Brief on Appeal in the above-captioned Application for Letters Patent. The Commissioner is hereby authorized to charge any fees necessitated by the filing of this Brief on Appeal, including the filing fee of \$330.00, and any necessary extensions of time required to maintain pendency of this application, be charged to Assignee's Deposit Account No. 06-1510.

Respectfully submitted,

Date: April 9, 2004

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PATENT

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Dear Sir:

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §1.192

In accordance with the provisions of 37 C.F.R. §1.192, Appellants submit the following Brief on Appeal.

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Ford Global Technologies, LLC, a Delaware Limited Liability Company. Assignment of the application was submitted to the U. S. Patent and Trademark Office on April 22, 2003, and recorded on the same date at Reel 013987, Frame 0838.

II. RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The status of the claims is as follows:

- (a) Claims 1 – 34 and 36 have been canceled; and
- (b) Claims 35 and 37 – 39 are pending and appealed.

Claims 35 and 37 – 39 on appeal are set forth in their entirety in Appendix I.

IV. STATUS OF AMENDMENTS

Claim amendments were made after final rejection in the Office Action dated October 21, 2003, and were entered by the Examiner per the Advisory Action dated March 11, 2004.

V. SUMMARY OF THE INVENTION

The present invention relates to a configurable roof rack system 10 for an automobile 12 (see, e.g., Paragraph 0014 of original specification, lines 1 - 3). With reference to Figs. 1 and 2, the collapsible storage surface is movable between a first position 22 generally

coincident with the roof 14 of the vehicle 12 and a second position 24 generally coincident with a lateral side 16 of the vehicle 12 (see, e.g., Paragraph 0015 of original specification, lines 3 - 6) to serve as a mounting surface on the side of a vehicle (see, e.g., Paragraph 17 of the original specification, lines 14 - 16). In addition, independent Claim 35, the only independent claim remaining in the application, also defines first and second connecting members 41, 43, 45, 47 that are hingedly connected to the storage surface 20, 30, 32 via track elements 36, 51, 53, 55 such that the first and second connecting members 41, 43, 45, 47 slide along corresponding first and second guide rails 38, 57 to move the storage surface 20, 30, 32 between the first and second positions 22, 24 (see, e.g., Paragraph 0018 of the substitute specification, lines 7 - 11, and Paragraph 0018 of the original specification, lines 7 - 8), which is depicted in Figs. 2 and 3.

The configurable roof rack system is selectively configurable to permit placement of large objects on top of the roof of the vehicle without encumbrance from the roof rack (see, e.g., Paragraph 0017 of the original specification, lines 10 - 14), or in the alternative objects can be mounted on the side of the vehicle supported by the re-configured storage surface of the roof rack system (see, e.g., Paragraph 0019 of the original specification, lines 8 - 10).

VI. ISSUES

The issues are as follows:

(1) Whether the additions to the specification identified by the Examiner constitute new matter and, thus, whether the Examiner's rejection of Claims 35 and 37 - 39

under 35 U.S.C. §112, first paragraph, due to the asserted incorporation of new matter into these claims, is proper.

(2) Whether the teachings of U. S. Patent No. 6,338,427 (Aftanas, et al) anticipate all of the limitations recited in Claims 35 and 37 – 39 such that the rejection of Claims 35 and 37 – 39 under 35 U.S.C. §102(e) is proper.

(3) Whether the Examiner's rejection of Claims 35 and 37 – 39 as being obvious over U. S. Patent No. 6,338,427 (Aftanas, et al) in view of Great Britain Patent No. 1,043,227 (Parkins) is proper.

VII. GROUPING OF CLAIMS

Claims 35 and 37 – 39 of the present application may properly be considered in one group that stand or fall together.

VIII. ARGUMENTS

1. New Matter Rejection Under 35 U.S.C. §112

As is detailed below, the Examiner's rejection of various elements added to the specification and to the claims as new matter is improper. The specification and drawings, as amended by the substitute specification and the proposed drawing corrections, properly define the structure set forth in independent Claim 35, which recites the storage system that is selectively movable between first and second positions by first and second connecting members

that are slidably mounted on guide rails and pivotally connect the storage surfaces, thus permitting movement between the first and second positions; in dependent Claim 37 which describes and depicts a side element that can receive a bungee cord; in dependent Claim 38 which describes and depicts a hinge bar that pivotally supports a collapsible rail for folding movement; and in dependent Claim 39 which positions the storage surface to support objects when deployed along the side of the vehicle.

While the inherent disclosure of the originally submitted specification and drawings was sufficient to enable one of ordinary skill in the art to make and use the claimed subject matter, as is reflected in the Declaration of Le Nguyen attached hereto as Appendix II, the amplified disclosure set forth in the substitute specification and the proposed corrected drawings specifically describes the structure necessary for the slidable and pivotal support of the storage surfaces for movement between the first position on the vehicle roof and the second position along the side of the vehicle, as well as the pivotal movement of the collapsible rails that form a part of the storage surfaces.

The best mode of the invention is reflected in the original and substitute specifications, as is described and shown in the prototype depicted in the provisional application on which the instant patent application claims domestic priority.

A. EXAMINER'S POSITION

The Examiner concludes that four elements added to the specification constitutes new matter in that the added subject matter is not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time the

application was filed, had possession of the claimed invention. These four elements are identified as follows:

- A. Multiple segments that form each of the collapsible side rails 26 (original reference number), identified in the amendments to the specification as collapsible rails 26, 27, 29 and 31.
- B. Collapsible rails attached by hinge bars for pivotal movement.
- C. Track elements hingedly affixed to the connecting members.
- D. Latching areas defined by recesses in the mounting elements.

These four elements deemed to be new matter by the Examiner correspond to the following limitations in the remaining claims:

- 1. a collapsible storage surface movable between closed and deployed positions in Claim 35;
- 2. first and second connecting members hingedly connected to the storage surface to permit movement of the storage surface between first and second positions in Claim 35;
- 3. first and second connecting members movably connected to corresponding first and second guide rails to permit the first and second connecting members to slide along the guide rails in Claim 35;
- 4. side elements including a recess for receiving a bungee cord in Claim 37;
and

5. a hinge bar and collapsible rail hingedly affixed to the hinge bars in Claim 38.

The Examiner states in the Advisory Action dated March 11, 2004, that even if the added subject matter simply clarifies the function of the roof rack, the amendments to the specification and drawings were not originally filed or disclosed, and thus constitute new matter.

B. CITATION OF AUTHORITIES

“[A]mendments that (1) merely clarify or make definite that which an originally-filed application expressly or inherently disclosed, or (2) conform the specification to the originally disclosed drawings or claims, do not violate the rule on new matter.” (Chisum 4:11.04) Furthermore, an amendment to a specification does not violate the new matter rule if it merely clarifies or completes the original disclosure, as the specification and drawings may be amended to conform to each other. (Chisum 4:11.04[2])

In Tektronix, Inc. v. United States, 445 F.2d 323, 326-7, 165 USPQ 392, 394 (Ct. Cl. 1971), the court held that the applicant was permitted to amend the drawing and specification in response to queries by the patent examiner, and thereby simply make explicit a disclosure which was implicit in the application as filed.

Chisum 4:11.04[2][a] informs us that the specification may be amended to clarify the original disclosure, quoting Michigan Carto Co. v. Sutherland Paper Co., 29 F.2d 179, 184 (6th Cir. 1928) that “insertions by way of amendment in the description or drawing, or both, of a patent application do not invalidate the patent,” (e.g. by violation of the new matter rule) “if they are only an amplification and explanation of what was already reasonably indicated to be within

the invention". Chisum 4:11.04[2] also quotes Quigley v. Zimmerman, 73 F.2d 499, 503 (CCPA 1934) as holding that "amendments may be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions". Furthermore, Chisum 4:11.04[2] instructs that the specification and drawings may be amended to conform to each other.

An amendment correcting an error in the specification is not new matter if "one skilled in the art would appreciate not only the existence of error in the specification by what the error is." In re Oda, 443 F. 2d 1200, 1205, 170 USPQ 268, 272 (CCPA 1971). In Corometrics Medical Systems, Inc. v. Berkeley Bio-Engineering, Inc. (DC N. Calif) 193 USPQ 467, the court held that an amendment that clarifies an inherent property of an invention as disclosed by the original application adds nothing to what a person skilled in the art would have learned from the original application, or includes matter clearly disclosed by the original application's drawings, and, therefore, does not constitute new matter.

Amendments to an application do not amount to new matter where they are explanatory of drawings as originally filed. Eversharp, Inc. v. Fisher Pen Co., Inc., 132 USPQ 423 (DC N Ill.) In re Wolfensperger, 133 USPQ 537 (CCPA) held that Patent Office Rules authorized amendment of words in the specification so as to add statements to conform to originally filed drawings; inquiry in each case is what drawing in fact discloses to one skilled in the art; whatever it does disclose may be added to the specification in words without being prohibited as new matter since what is originally disclosed cannot be new matter.

C. APPELLANTS' POSITION

Appellants respectfully submit that the amendments made to the specification and claims during prosecution of the instant application to insert the four elements identified in Section A above do not constitute new matter for at least the following reasons:

1. The amendments conform to the disclosure of the originally filed drawings as defined by one of ordinary skill in the art.
2. The amendments add nothing to what a person skilled in the art would have learned from the original application.
3. The amendments serve to cure defects, obvious to one skilled in the art, in the written description of the invention.
4. The amendments were made in response to queries by the patent examiner, and thereby simply make explicit a disclosure that was implicit in the application as filed.
5. The amendments conform the specification to the originally disclosed drawings and serve to merely clarify properties of the invention that were inherently disclosed in the originally filed application.
6. The amendments merely conform the written specification to the disclosure of the originally filed drawings.
7. The amendments are merely an amplification and explanation of what was already reasonably indicated to be within the disclosure of the invention.

D. DISCUSSION

In support of Appellants' assertion that the added elements were inherently disclosed in the originally filed patent application and in response to the Final Office Action, Appellants submitted a Declaration by Le Nguyen, a mechanical engineer with 25 years of experience in automotive design and related technology. A copy of Mr. Nguyen's Declaration is attached hereto as Appendix II. Mr. Nguyen is a mechanical engineer with design experience in automobiles, though not explicitly in the design of roof rack systems, and thus qualifies as one of ordinary skill in the art pertaining to the invention disclosed within the instant application.

The Nguyen Declaration clearly supports that the amendments made to the application, deemed by the Examiner as constituting new matter, are a clarification of the inherent disclosure of the originally filed drawings. Taking each of the four elements separately, Appellants respectfully submit that each of the seven reasons defined in Section C above apply to each of these elements, thus preventing them from being new matter.

1. **Multiple segments that form each of the collapsible side rails 26 (original reference number), identified in the amendments to the specification as collapsible rails 26, 27, 29 and 31.**

This amendment is reflected in Paragraphs 17 and 19 of the specification, in reference number changes to the drawings, and in independent Claim 35. Appellants submit that it is clear from the original drawings filed in this patent application that the collapsible rails 26 are formed of individual segments, which can be seen in the original Figs. 1 – 4, in that the front and rear rails are separable from the adjacent side rails.

Referring first to the depiction of Fig. 1, it can be seen that the collapsible rails are raised to form a basket, but in Fig. 2, the front and rear side rails are moved to an alternate collapsed position. In Fig. 4, all of the rails are moved into collapsed positions. Unless the collapsible rails 26, 27, 29, 31 were formed of multiple individual segments, the respective individual portions of the collapsible rails could not be moved into a collapsed position relative to the other rail segments. Clearly, this is an inherent teaching found within the original drawings filed in the instant patent application, as is reflected in Paragraphs 6 – 8 of the Nguyen Declaration. Thus, since the amendment makes explicit inherent teachings of the original drawings, these amendments do not constitute new matter. Tektronix, Inc. v. United States, *ibid.*

During prosecution, the Examiner raised a number of questions regarding how these rails could move into these respective positions, which resulted in the amendments to the specification that was subsequently deemed new matter by the Examiner. As is reflected in the Tektronix case herein, Appellants amended the specification in response to the Examiner's inquiries to make explicit what was otherwise an inherent disclosure in the drawings. As supported in the aforementioned Nguyen Declaration, this amplification of the disclosure of the invention is within the skill of one of ordinary skill in the art and is an explanation of what was reasonably indicated in the drawings depicting the invention.

Furthermore, Figures 9 and 12 of the provisional patent application on which the instant patent application claims domestic priority shows these side rails as being composed of multiple segments. Thus, the formation of the side rails from multiple segments is an inherent teaching carried through from the provisional application on which the instant application claims priority.

Turning to Paragraphs 6 – 10 of the Nguyen Declaration, one skilled in the art affirmatively establishes that the formation of the rails from multiple segments is clearly understood from the drawings. The Nguyen Declaration supports that this is material that would be learned by a person skilled in the art from the original application, reading the specification and looking at the drawings.

For the reasons given above, Appellants respectfully submit that this element does not constitute new matter.

2. **Collapsible rails attached by hinge bars for pivotal movement.**

This amendment is reflected in Paragraphs 17 and 18 of the specification and in reference number changes to the drawings. As supported in the aforementioned Nguyen Declaration, the original drawings filed in this patent application clearly reflect that the collapsible side rails 26 are pivotable to move between the raised position depicted in Fig. 1, and on the left side of the vehicle in Fig. 2, to the inwardly lowered position shown in Fig. 2 on the front right side of the vehicle. Fig. 4 clearly shows that all four of the side rail members can be lowered into the inwardly collapsed position.

The use of the term “hinge bars” is merely reflective of the pivotal movement of the side rails about the corresponding hinge bar. Although the amendments to the specification first give names and reference numbers to these structural components, the structure is clearly shown in the originally submitted drawings and no new structure was added to the disclosure by the amendments to the specification and drawings. Accordingly, Appellants have merely

amplified and explained in a more explicit manner the structure and features depicted at least inherently in the originally filed drawings.

One of ordinary skill in the art, as is reflected in Paragraphs 12 - 15 of the Nguyen Declaration, is clearly taught by the originally submitted disclosure that the collapsible side rails pivot about the bottom rail member, which has been described in the amendments to the specification as the hinge bars 33, 35, 37, 39. Accordingly, the corresponding amendments to the specification do not incorporate new matter as Appellants are not precluded from clarifying their disclosure by adding reference numbers and an amplified detailed description to the specification based on the drawings. (Corometrics Medical Systems, Inc. v. Berkeley Bio-Engineering, Inc. and In re Wolfensperger)

In addition, the provisional patent application upon which the instant application claims domestic priority clearly shows in Figure 13 the details by which the collapsible side rails are pivotally mounted for collapsible movement. As depicted in Figure 13 of the corresponding provisional patent application, a pin is demonstrated as forming a hinged (or pivoted) connection between the collapsible rail and the track elements. Furthermore, the written description of the provisional application (e.g., in the last sentence of the first paragraph on page 2 of the provisional application) describes the side rails as being "folded down" so that it is oriented close to the vehicle body. "Folding" is a term corresponding to pivotal movement.

Accordingly, Appellants respectfully submit that this element and the corresponding amendments to the specification and drawings do not incorporate new matter.

3. **Track elements hingedly affixed to the connecting members.**

This amendment is also reflected in Paragraphs 17 and 18 of the specification and in reference number changes to the drawings. As noted in the Nguyen Declaration, the original drawings filed in this patent application reflect that the rear collapsible side rails 26 are pivotable to move between the raised position (depicted in Fig. 1, and on the left side of the vehicle in Fig. 2) to the outwardly lowered position (shown in Fig. 2 on the rear right side of the vehicle). Fig. 4 shows that the rear side rail members can be lowered into both the inwardly collapsed position and the outwardly collapsed position.

The right rear portion of the roof rack assembly depicted in Fig. 2 of the originally submitted drawings reflects that the roof rack portion 30 is outwardly slidable and pivotable downwardly to re-position the roof rack portion 30 in a second position along the side of the vehicle. Furthermore, the original drawings depict a representative connecting member that one of ordinary skill in the art would understand would be operable to be slidably received within the corresponding guide rail and then to permit a pivotal movement of the roof rack portion 30 to position the roof rack into the second position along side of the vehicle.

Furthermore, the corresponding provisional patent application upon which the instant patent application claims domestic priority, teaches one of ordinary skill in the art that such a pivotal connection can be accomplished with a pin defining a hinged connection, as can be found in Figure 4 and in Figure 13.

The provisional application also describes in the paragraph spanning from the bottom of page 2 to the top of page 3 that the portions of the roof rack will slide on the tracks and when positioned in the "folded down position", the side rail may also be "folded down". This

language inherently incorporates the teaching amplified in the subject amendments to the specification in that a “connecting member” will be slidably received within the guide rails that would permit the structure to be moved outboard and pivoted down into the position adjacent the side of the vehicle.

In view of the above comments, Appellants respectfully submit that such amplification is permissible and does not constitute the introduction of new matter.

4. **Latching areas defined by recesses in the mounting elements.**

This amendment is reflected in Paragraph 20 of the specification. The original drawings filed in this patent application reflect that the mounting members are provided with identified recesses 52 in which attachment devices can be connected to serve as latching areas.

In addition, the provisional patent application upon which the instant application claims domestic priority, at the end of the second complete paragraph on page 2, further specifies that the retention openings can also be formed in the “B” and “C” pillars of the vehicle to retain a clip or hook of a bungee cord to retain cargo.

Such latching or retainment structure is within the capability and understanding of one of ordinary skill in the art, as is reflected in Paragraphs 16 and 17 of the aforementioned Nguyen Declaration.

Accordingly, Appellants respectfully submit that the amendments to the specification and claims relating to this element also do not incorporate new matter.

5. **Changes to the Drawings.**

With respect to the changes made to the drawings, the addition of reference numbers and the labeling or identification of previously existing structural parts of the originally disclosed configurable roof rack system is in conformity with the understanding of one of ordinary skill in the art upon a reading of the instant disclosure. Furthermore, Appellants are permitted to conform the drawings to the specification and vice-versa. (Chisum 4:11.04[2]) Thus, Appellants respectfully submit that the changes to the drawings to add additional reference numbers also do not constitute new matter as such reference numbers only serve to clarify, amplify and/or explain the teachings of the specification and, accordingly, no new structure is added to the drawings. The insertion of lines in the left and right side rails to reflect the differences between the segment 27 and 29 merely places Fig. 1 in conformity with the other Figures originally presented in the application.

For the reasons given above, Appellants respectfully request that the changes to the drawings also do not incorporate new matter.

6. **Related Collateral Issues**

The Examiner has raised a couple of collateral issues relating to the issue of new matter. One such issue is a statement / question by the Examiner that portions of the rails 26 appear to disappear when the rails are in the collapsed position and that it would appear as though the forward portion of the rails is permanently attached to the roof of the vehicle. In response, Appellants have argued that these details are not pertinent to the invention as set forth in the claims discussed below. As reflected in Paragraph 10 of the Nguyen Declaration, one

skilled in the art would appreciate that the roof rack is not casually positioned in any of the alternative configurations taught in the instant patent application. The appropriate portions of the roof rack must be manually positioned into the desired configuration.

In response to the Examiner's inquiry, an explanation was given to the Examiner that the trim pieces could interconnect adjacent segments of the collapsible rails, which could then be removed and stored until the roof rack is returned to the upright configuration. The same could be true for any other aesthetic trim pieces that provide a desirable roof rack appearance. Other retractable structures could also provide the same function. Nevertheless, the existence of and the disposition of any such trim pieces or such retractable structures have nothing to do with the configurable roof rack system disclosed and are not claimed in the instant application.

As for another collateral issue relating to new matter, the Examiner has noted that the roof rack appears to be permanently attached to the vehicle roof. In response, Appellants direct the Board's attention to the lack of teaching in the specification to support such a statement. The disclosed invention is one of a roof rack system that can be configured into at least three different orientations to provide for a variety of functions for carrying cargo, including an upright basket configuration, an inwardly collapsed configuration to form an essentially flat roof shape, and an outwardly disposed configuration in which cargo can be supported along the sides of the vehicle. Having the roof rack rails permanently attached to the roof would be contradictory to the teachings of Appellants' disclosure. Thus, this collateral issue is also a red herring as no corresponding amendment to the specification or claims has been made.

E. SUMMARY

The remaining claims stand rejected under 35 U.S.C. §112, first paragraph, as incorporating new matter. The Examiner states in the advisory Action that even if the subject matter added to the original specification is a clarification of the function of the apparatus in the original disclosure, that the subject matter could not be added to the specification because it was not originally filed or disclosed. As stated in In re Oda, ibid at p. 1203, “anything inserted in a specification that was not there before is new to the specification, but that does not necessarily mean it is prohibited as ‘new matter’.”

Quite simply, the Examiner’s position on new matter is erroneous. Just because something is new to the specification does not make the additional material new matter. As is shown above, the amendments to the specification and claims serve merely to amplify and make explicit the teachings of the originally filed disclosure of the invention. Furthermore, these additions to the specification were made in response to inquiries from the Examiner as to the inherent teachings of the disclosure. The added material is within the understanding of one of ordinary skill in the art upon a reading of the original disclosure.

Accordingly, Appellants respectfully request that the amendments to the specification and drawings deemed new matter by the Examiner be permitted and that the rejection to Claims 35 and 37 – 39 under 35 U.S.C. §112, first paragraph, be withdrawn, permitting Claims 35 and 37 – 39 to be passed to allowance.

2. Anticipation Rejection Under 35 U.S.C. §102(e)

A. EXAMINER'S POSITION

Although the Examiner does not re-assert or even address the 102(e) rejection in the Advisory action, this rejection has not been withdrawn and, therefore, remains outstanding. The Examiner asserts in the Final Rejection that Aftanas teaches a roof rack with a collapsible storage surface 202 that moves from atop the roof of the vehicle (figure 18) to a position behind the vehicle (figure 19). The first and second rails 218 allow first and second connecting members 210 to slide along for movement of the storage surfaces between the two referenced positions. At least one mounting element 214 is on the side of the vehicle with recesses 212 to provide a place for attachment.

B. APPELLANTS' POSITION

Appellants respectfully submit that Claim 35 specifically defines a configurable roof rack system that permits first and second connecting members to slide along the first and second guide rails to move the storage surface from a first position on top of the vehicle roof to a second position along a lateral side of the vehicle to serve as a mounting surface on the side of the vehicle. Furthermore, Claim 35 defines the collapsible storage surface as being configurable in a closed position and a deployed position. The dependent claims provide additional structure such as collapsible rails that are pivotally supported on hinge bars to permit movement between a lowered closed position and an upright operative position.

On the other hand, the Aftanas roof rack system is operable to deploy the storage surface behind the vehicle, rather than to the lateral side of the vehicle as in the present invention and, thus, cannot anticipate or make obvious the claim limitations of independent Claim 35.

More particularly, the Aftanas roof rack is not operable to allow the user to store items on top of the vehicle, in addition to mounting items on the side of the vehicle. Aftanas only permits objects to be mounted on the rear of the vehicle that would be limited in length to the width of the vehicle. Furthermore, Aftanas has no teaching or suggestion directed to the structure of a collapsible storage surface that is configurable between closed and deployed positions, in addition to being movable between positions on top of the vehicle and on the lateral side of the vehicle.

Additionally, Aftanas does not contain any teaching or suggestion to meet the limitations of dependent Claims 38 and 39. In particular, there is no teaching relating to the collapsible rail that is pivotally movable to permit oversized objects to be mounted on top of the vehicle when the storage surface is in the first position (on top of the vehicle – Claim 38) and positionable to support objects mounted on the storage surface when deployed along the side of the vehicle (Claim 39). In fact, Aftanas contains no teaching or suggestion whatsoever relating to a collapsible rail.

C. SUMMARY

The remaining claims (35 and 37 – 39) stand rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,338,427 (Aftanas). Aftanas, however, cannot meet the structural limitations of independent Claim 35, nor the additional limitations provided by

dependent Claims 37 – 39. Accordingly, Appellants respectfully submit that the Examiner's rejection of Claims 35 and 37 – 39 as being anticipated by Aftanas is not proper and should be reversed, thereby permitting these claims to be passed to allowance.

3. Obviousness Rejection Under 35 U.S.C. §103(a)

A. EXAMINER'S POSITION

Although the Examiner does not re-assert or address the 103(a) rejection in the Advisory action, this rejection has not been withdrawn and, therefore, remains outstanding. The Examiner asserts in the Final Rejection that, although Aftanas teaches rails 204 and 206 that form a storage surface 202, Aftanas does not teach rails 204 as being collapsible or hingedly connected. The Examiner adds that Parkins teaches a similar roof rack having rails 24 that are hingedly connected to the front and rear rails of the roof rack to allow for the rails 24 to collapse and extend upwardly. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide rails 24 as taught by Parkins in place of rails 204 on Aftanas to increase the storage capacity of the roof rack.

B. APPELLANTS' POSITION

Appellants respectfully submit that Claim 35 of the present application specifically defines a configurable roof rack system that permits first and second connecting members to slide along the first and second guide rails to move the storage surface from a first

position on top of the vehicle roof to a second position along a lateral side of the vehicle to serve as a mounting surface on the side of the vehicle. Dependent Claims 38 and 39 define a collapsible rail structure that is operable to retract into an out-of-the-way position (the closed position) and to be deployed to support objects when the storage surface is in the second position on the lateral side of the vehicle or to form the basket structure when the storage surface is in the first position on top of the vehicle roof.

Appellants respectfully submit that Parkins adds nothing to the teachings of Aftanas to meet the specific limitations recited in independent Claim 35. Appellants admit that Parkins does teach side basket railings on a roof rack device that are movable between a lowered, collapsed position and a raised operative position on top of the vehicle roof. Parkins, however, contains no teaching or suggestion whatsoever for a configurable roof rack system that is movable between a position on top of the vehicle and a position on the lateral side of the vehicle. Furthermore, Parkins contains no teaching or suggestion for a collapsible rail that can be used to support objects mounted on a storage surface oriented along the side of the vehicle.

Accordingly, Appellants respectfully submit that the Aftanas / Parkins combination cannot meet or make obvious the limitations of Claims 35 and 37 – 39.

C. SUMMARY

The remaining claims (35 and 37 – 39) stand rejected under 35 U.S.C. §103(a), as being obvious over U. S. Patent No. 6,338,427 (Aftanas) in view of Great Britain Patent No. 1,043,227 (Parkins). Neither reference, whether taken singly or in combination can meet the structural limitations of independent Claim 35, nor the additional limitations provided by

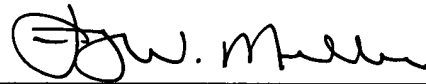
dependent Claims 37 – 39. Accordingly, Appellants respectfully submit that the Examiner's rejection of Claims 35 and 37 – 39 as being obvious over Aftanas in view of Parkins is not proper and should be reversed, permitting these claims to be passed to allowance.

This Brief on Appeal is being filed in triplicate. Appellants respectfully request that any fees necessitated by the filing of this Brief on Appeal, including the statutory filing fee of \$330.00 and any necessary extensions of time required to maintain pendency of this application, be charged to Assignee's Deposit Account No. 06-1510.

Respectfully submitted,

Date: _____

April 9, 2004



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**APPENDIX I****CLAIMS 35 AND 37 – 39 ON APPEAL:**

35. A re-configurable vehicle roof rack system comprising:
- a collapsible storage surface movable between a first position and a second position, the collapsible storage surface having a closed position and a deployed position;
 - a first guide rail and a second guide rail affixed to the vehicle roof;
 - a first connecting member moveably affixed to the first guide rail and hingedly connected to the storage surface;
 - a second connecting member moveably affixed to the second guide rail and hingedly connected to the collapsible storage surface wherein the first and second connecting members slide along the first and second guide rails to move the storage surface between a first position generally coincident with a roof of a vehicle and a second position wherein the collapsible storage surface being generally coincident with a lateral side of a vehicle and while in the deployed position serve as a mounting surface on the side of a vehicle.
37. The re-configurable vehicle roof rack system defined in claim 35 further comprising a side element defining a recess for receiving a bungee cord.

38. The re-configurable vehicle roof rack system defined in claim 35 further comprising a first track element and a second track element defining the lateral edges of the storage surface;

a hinge bar affixed between the first track element and the second track element;

and

a collapsible rail hingedly affixed to the hinge bar wherein the collapsible rail folds down to provide for the mounting of oversized objects along the top of the vehicle when the storage surface is in the first position.

39. The re-configurable vehicle roof rack system defined in claim 38, wherein the collapsible rail is raised when the collapsible storage surface is deployed along the side of the vehicle whereby the collapsible is operative to vertically support objects mounted on the deployed storage surface.

To: Grigette B.

APPENDIX II

Fr: Le Nguyen

PATENT

Docket No. 201-0238 GMB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: BRUCE P. WILLIAMS, ET AL

Serial No.: 09/682,594

Art Unit: 3727

Filed: September 25, 2001

Examiner: N. J. Newhouse

For: CONFIGURABLE ROOF RACK SYSTEM

Commissioner for Patents

Mail Stop AF

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

DECLARATION UNDER 37 C.F.R. 1.132

I, Le Nguyen, hereby declare as follows:

1. I am employed by Ford Motor Company as an engineer working in North American Engineering. I have been employed in the automotive industry as a mechanical engineer for 25 years and have had 3 patents issued to me.

2. I am familiar with automotive roof rack systems utilized on automotive vehicles. I am familiar with the mechanical drawings in general and with the mechanical drawings utilized at Ford Motor Company in the manufacture of vehicles.

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3. I have reviewed the drawings and specification originally submitted in the above-captioned patent application (U. S. Serial No. 09/682,594) and with the photographs, drawings and specification originally submitted as U. S. Provisional Patent Application Serial No. 60/259,005, filed on December 29, 2000. I have also reviewed the Office Action dated October 21, 2003, in which the Examiner deems that amendments previously made to the specification included "new matter".

4. I understand from the attorneys working on the subject patent application that the issue is whether or not the subject matter included in the amendments to the specification is disclosed to one of ordinary skill in the art from the materials originally submitted in the subject patent application, including the drawings.

5. The issues of new matter have been defined to me as being the following:

a. Do the originally filed papers include a teaching or disclosure of multiple segments forming the collapsible rails;

b. Do the originally filed papers include a teaching or disclosure of the collapsible rails being attached by hinge bars for pivotal movement;

c. Do the originally filed papers include a teaching or disclosure of track elements hingedly affixed to the collapsible rails; and

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d. Do the originally filed papers include a teaching or disclosure of latching areas defined by recesses in the mounting members of the roof rack?

6. My review of the papers originally filed in the subject patent application reveals that the drawings clearly show that the collapsible rails are formed from multiple segments, which have been identified in the subsequent amendments to the specification as being collapsible rails 26, 27, 29 and 31. Clearly, the original drawings reflect that the front and rear rails are separable from the adjacent side rails. In originally submitted Fig. 2, the disclosure is clear that the front and rear side rails can be moved to alternate collapsed positions and in originally submitted Fig. 4, all the rails are moved into such collapsed positions.

7. Unless the collapsible rails in the originally submitted drawings were formed of multiple individual segments, the respective individual portions of the collapsible rails could not be moved into a collapsed position relative to the other rail segments. Accordingly, the originally submitted drawings disclose to me, one of ordinary skill in the art, that the collapsible rails are necessarily formed of multiple segments and, thus, do not constitute new matter with respect to subsequent amendments to the specification.

8. Furthermore, my review of the originally submitted provisional application materials reflect that Figures 9 and 12 of the provisional patent application clearly show these side rails as being composed of multiple segments.

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9. The aforementioned Office Action comments that portions of the rails 26 disappear when the rails are in the collapsed position and that it would appear as though the forward portion of the rails is permanently attached to the roof of the vehicle. One of ordinary skill in the art would understand that the individual segments of the collapsible rails could be connected by removable trim pieces or other retractable structure that would allow the individual collapsible rails to pivotally move into one of the three alternate positions (upright, outboard and inboard). Such trim pieces and/or retractable structure could provide a desired aesthetic appearance as depicted in Fig. 1. To provide such trim and/or retractable structure would certainly be within the capability of one of ordinary skill in the art having the disclosure of the subject patent application before him/her. Accordingly, the apparent disappearance of portions of the collapsible rails to effect pivotal movement of the collapsible rails is within the understanding of one of ordinary skill in the art.

10. Furthermore, the positioning of the roof rack in one of the three depicted positions is not something that would be casually accomplished. The appropriate portions of the roof rack must be manually positioned into the desired configuration. Accordingly, trim pieces or other retractable structure that would interconnect adjacent segments of the collapsible rails could be removed and stored until the roof rack is returned to the upright (basket-forming) configuration. The same could be true for any other aesthetic trim pieces that provide a desirable roof rack appearance.

11. I can find no indication within the originally submitted specification or drawings, or in the provisional

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patent application, to indicate that the roof rack railings would be permanently attached to the vehicle roof as is suggested within the October 21, 2003, Office Action.

12. My review of the papers originally filed in the subject patent application reveals that the drawings clearly show that the collapsible rails are pivotally mounted for respective individual movement about an axis corresponding to a structural bar that is subsequently referred to in amendments to the specification as a hinge bar. The original papers submitted in the subject patent application do not refer to the pivoted structure as a "hinge bar", but such a definition is a reasonable conclusion from the pivotal movement included within the teachings thereof.

13. The original drawings filed in this patent application clearly reflect that the collapsible side rails 26 are pivotable in moving between the raised position depicted in Fig. 1, and on the left side of the vehicle in Fig. 2, to the inwardly lowered position shown in Fig. 2 on the front right side of the vehicle. Fig. 4 clearly shows that all four of the side rail members can be lowered into the inwardly collapsed position.

14. I believe that the use of the term "hinge bars" is merely reflective of the pivotal movement of the side rails about the corresponding bottom member of the rail structure and, therefore, is within the teachings of the originally submitted specification and drawings.

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15. The provisional patent application clearly teaches one of ordinary skill in the art that such a pivotal connection can be accomplished with a pin defining a hinged connection, as can be found in Figure 4 and in Figure 13 of the provisional application.

16. My review of the papers originally filed in the subject patent application reveals that the drawings clearly show that the mounting members are provided with identified recesses in which attachment devices can be connected to serve as latching areas.

17. The provisional patent application further specifies that the retention openings can also be formed in moldings along the "B" and "C" pillars of the vehicle to retain a clip or hook of a bungee cord to retain cargo.

18. My review of the papers originally filed with the subject patent application leads me to the conclusion that the features identified in claims 35 - 39 fall within the scope of the teachings of the original papers submitted in the subject patent application and within the papers constituting the provisional patent application that corresponds to the subject patent application.

Respectfully submitted,

Date:

2/09/2004


Le Nguyen